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EXAMINER

RIVIERE, HEIDI M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/824,056	Applicant(s) BAUM, DIANE T.	
	Examiner HEIDI RIVIERE	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Examiner used **Apgar, IV (US 5,680,305)** (hereinafter "**Apgar**"), **Burton (US 6,782,321 B1)**, **McDaniel et al. (US 5,105,365)** (hereinafter "**McDaniel**"); and "**Annual Environmental Performance Report: Naval Air Engineering Station Lakehurst New Jersey**", October 30, 2002 (hereinafter "**Naval Air**") to reject claims 1-20.

2. Applicant argues that Apgar does not teach assessing the environmental risk by investigating the state of current or future regulatory compliance. However, Apgar teaches in col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade, Area and Risk". "Risk" means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate. The claims 1-5, 9, 11, 12, 17, 19 and 20 rejections have been revised to portray a

3. Claim 15 was rejected under 35 USC 112 paragraphs 1 and 2. This claim has been amended and therefore the 35 USC 112 paragraph 1 rejection is withdrawn. However, the claim remains rejected under 35 USC 112 Paragraph

2.

4. Please note the new rejection based on 35 USC 101 as applied below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 15** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 states “said customers being willing and able to grant to said financial institution rights”. There are many details that are confusing as presented in the claims. It remains unclear what institutional rights are being referred to – is it the right to use something of the customer, the right to act on behalf of the customer, the right to ownership to the customers business or property, or the right to ownership on default?

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 1-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to recent Federal Circuit decisions, in order for a process to be a proper process under 35 USC 101, it must be tied to another statutory class of invention (such as a particular apparatus) or transform subject matter to a different state or thing. As is the case in the current application, if neither of these requirements is met by the claim, the method is not a patent eligible

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process under section 101. Therefore, although Applicant claims the steps of a process, Applicant fails to claim or mention the presence of another statutory class or provide limitations in the current application which detail the transformation of the subject matter to a different state or thing. For example, claim 1 assesses risk data and assigns indicators to generate a report of the data. Claims 15 and 19 present the evaluation of risk by an auditor. And claim 20 provides a database, searching the database and presenting a report from data obtained from the database. There is no mention of another statutory class and the presentment of data in a report cannot be considered to have transformed subject matter to a different state or thing since the subject matter remains data after the conversion. Therefore, Applicant's claimed invention is not statutory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-5, 9, 11, 12, 17, 19 and 20** rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Apgar, IV (US 5,680,305)** (hereinafter "**Apgar**").

11. **With respect to claims 1 and 17:** Apgar discloses:

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- assessing the environmental risk associated with a business, said business comprising a piece of land, a service operation, a current state of regulatory compliance, and future requirements for regulatory compliance; assigning a first indicator to said environmental risk associated with said piece of land; (col. 3, lines 35-67 – banks, pension funds and insurance companies are customers of invention as well as property developers/managers, government agencies and many others; col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.")
- assigning a second indicator to said environmental risk associated with said service operation; (col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.")
- assigning a third indicator to said environmental risk associated with said current state of regulatory compliance; (col. 1, line 53-col.

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2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.")

- assigning a fourth indicator to said environmental risk associated with said future requirements for regulatory compliance; (col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.") and
- generating a report including said first, second, third, and fourth indicators. (col. 3, lines 35-42 – information is delivered to business entity in the form of a report)

It would have been obvious to one of ordinary skill in the art of the invention to understand that risk assessment would include "current state of regulatory compliance, and future requirements for regulatory compliance".

Furthermore, the data identifying type of and use of the indicator is non-functional descriptive data.

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When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of and use of the indicator adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any

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differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

12. **With respect to claim 2:** Apgar discloses wherein said transaction is selected from the group consisting of a loan transaction, an insurance transaction, or a venture capital transaction. (col. 3, lines 35-67 – banks, pension funds and insurance companies are customers of invention as well as property developers/managers, government agencies and many others)

13. **With respect to claim 3:** Apgar discloses wherein said first, second, third, and fourth indicators are numerical scores. (col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "'Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.")

14. **With respect to claims 4, 9 and 11:** Apgar discloses wherein said report further includes a final indicator, said final indicator comprised of the sum of said first, second, third, and fourth indicators. (col. 1, line 53-col. 2, line 3; col.2, lines 40-61; col. 13, lines 53-58 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "'Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business

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entity's occupancy in the real estate."; "total risk indicator is broken into a first, second, third and fourth risk indicator")

15. **With respect to claim 5:** Apgar discloses wherein said numerical scores for each of said first, second, third, and fourth indicators are obtained by summing the values of a plurality of interim indicators. (col. 1, line 53-col. 2, line 3; col.2, lines 40-61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "'Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.")

16. **With respect to claim 12:** Apgar discloses wherein said report further comprises an explanation of low scores achieved. (col. 5, lines 20-31 – "low scores highlights the need for the Business Entity's top management to focus on real estate issues")

17. **With respect to claim 20: (currently amended)** Apgar discloses:

- providing a central database, said central database containing information pertaining to the environmental risk associated with a piece of land or service; and searching said central database in order to evaluate said environmental risk associated with said piece of land or said service, said environmental risk comprising the current state of regulatory compliance; (col. 15, lines 26-40 – database provided to store real estate indicators of real estate condition related to risk; col. 1, line 53-col. 2, line 3; col.2, lines 40-

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61 - "The Score is generally determined by five indicators of Amount, Price, Grade. Area and Risk". "Risk' means an indicator of the financial, market and environmental exposure of real estate and of the financial, Market and environmental risks associated with the employees and the business entity's occupancy in the real estate.") and

- generating a report summarizing said environmental risk associated with said piece of land or said service. (col. 3, lines 35-42 – information is delivered to business entity in the form of a report)

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Apgar in view of Burton (US 6,782,321 B1)**.

20. **With respect to claim 6:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said plurality of interim indicators are derived from ASTM guidelines. However, Burton teaches wherein said plurality of interim indicators are derived from ASTM guidelines. (col. 8, lines 28-49 – ASTM standards are used to conduct aquifer tests for environmental site characterization).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the numerical scores in Apgar with the indicators derived using ASTM guidelines in Burton because of the need conduct aquifer tests for environmental site characterization. (Burton: col. 8, lines 28-49).

21. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Apgar in view of McDaniel et al. (US 5,105,365)** (hereinafter “**McDaniel**”).

22. **With respect to claim 10:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said first, second, third, and fourth indicators are alphabetical references. However, McDaniel teaches wherein said first, second, third, and fourth indicators are alphabetical references. (Fig 3(a) – items in risks table listed in alphabetical order).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of indicators in Apgar with the alphabetical based identification in McDaniel because this allows others to quickly notice the areas that require additional attention.

23. **Claims 7, 8, 13-16 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Apgar** in view of “**Annual Environmental Performance Report: Naval Air Engineering Station Lakehurst New Jersey**”, October 30, 2002 (hereinafter “**Naval Air**”).

24. **With respect to claim 7:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said first, second, third, and fourth

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indicators are reviewed and adjusted by a knowledgeable person. However, Naval Air teaches wherein said first, second, third, and fourth indicators are reviewed and adjusted by a knowledgeable person. (section 4.1 – Station is environmental auditor; Audit uses ISO 14001 standard).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of indicators in Apgar with the review by an auditor or other knowledgeable person in Naval Air because of the need identify areas of nonconformance. (Naval Air section 4.1)

25. **With respect to claim 8:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said first, second, third, and fourth indicators are colors. However, Naval Air teaches wherein said first, second, third, and fourth indicators are colors. (section 4.1 – compliance audit include “checklist that identifies the compliance topics with the greatest risk. Each media area is then scored and assigned a relative compliance risk on a Red-Yellow-Green basis.”)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of indicators in Apgar with the color based identification in Naval Air because this "allows management to quickly see the areas that require additional oversight or resources" (Naval Air section 4.1)

26. **With respect to claim 13:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said report further comprises a listing of required environmental permits. However, Naval Air teaches wherein said report

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further comprises a listing of required environmental permits. (sections 4.3 to 5.8 - permits like EPCRA listed if there is an exceedances of permits)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of indicators in Apgar with listing permits like EPCRA because of the need to note exceedances of the permit.

27. **With respect to claim 14:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said report further comprises a list of corrective action recommendations based on said audit. However, Naval Air teaches wherein said report further comprises a list of corrective action recommendations based on said audit. (sections 2.1 – corrective action reports are part of the analysis process)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of indicators in Apgar with the corrective action reports of Naval Air because this "allows management to quickly see the areas that require additional oversight or resources")(Naval Air section 4.1)

28. **With respect to claim 15: (currently amended)** Apgar teaches:

- wherein said financial institution comprises individual customers in need of said financial assistance from said financial institution, each of said customers being willing and able to grant to said financial institution rights in collateral in exchange for said financial assistance (col. 3, lines 35-67 – banks, pension funds and insurance companies are customers of invention as well as

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property developers/managers, government agencies and many others)

- wherein, said environmental auditor is able to evaluate said environmental risk for each of said collateral at a unit price that is lower than the unit price of said financial institution for evaluating said environmental risk for a single customer. (col. 4, lines 1-5 – invention provides cost-effective service)

Apgar does not teach, however, Naval Air teaches

- an environmental auditor performing an evaluation of environmental risk for a financial institution capable of rendering financial assistance; wherein said evaluation comprises an environmental risk associated with said collateral proffered by each of said customers in said population. (section 4.1 – Station is environmental auditor; Audit uses ISO 14001 standard)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the financial assistance in Apgar with the review by an auditor or other knowledgeable person in Naval Air because of the need identify areas of nonconformance. (Naval Air section 4.1).

29. **With respect to claim 16:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said environmental auditor evaluates said risk associated with said collateral using a universal environmental auditing method. However, naval Air teaches wherein said environmental auditor

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evaluates said risk associated with said collateral using a universal environmental auditing method. (section 4.1 – Audit uses ISO 14001 standard)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the financial assistance in Apgar with the review by an auditor or other knowledgeable person with a universal auditing method in Naval Air because of the need to have a system that is easily understood by those in the art.

30. **With respect to claim 18:** Apgar discloses the limitations in the rejections above. Apgar does not teach wherein said environmental auditor employs personnel at one or more regional offices and at a headquarters, wherein at least a portion of said environmental audit is carried out by said personnel at said regional office and reported back to said personnel at said headquarters. However, Naval Air teaches wherein said environmental auditor employs personnel at one or more regional offices and at a headquarters, wherein at least a portion of said environmental audit is carried out by said personnel at said regional office and reported back to said personnel at said headquarters. (section 2.2 – Public works environmental branch reports to commanding officer)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the financial assistance in Apgar with the managerial structure of Naval Air because of the need to have more employees to carry out reviews.

31. **With respect to claim 19: (currently amended)** Apgar discloses:

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- wherein said insurance company comprises individual customers in need of said insurance policies from said insurance company, each of said customers being involved in a business operation; (col. 3, lines 35-67 – banks, pension funds and insurance companies are customers of invention as well as property developers/managers, government agencies and many others)

Apgar does not teach, however Naval Air teaches:

- wherein, said environmental auditor is able to evaluate said environmental risk associated with each of said business operations at a unit price that is lower than the unit price of said insurance company for evaluating said environmental risk for a single business operation; an environmental auditor performing an evaluation of environmental risk for an insurance company capable of issuing insurance policies; wherein said evaluation of environmental risk is associated with said business operations of said customers; said environmental risk comprising the current state of regulatory compliance; (section 4.1 – Station is environmental auditor; Audit uses ISO 14001 standard)

It would have been obvious to one of ordinary skill at the time of the invention to combine the insurance company services in Apgar with the review by an auditor or other knowledgeable person in Naval Air because of the need identify areas of nonconformance. (Naval Air section 4.1)

OTHER REFERENCES CONSIDERED

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32. Merrett et al. (US 7,081,091 B2) was also considered for claims 8 and 10.

CONCLUSION

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/H. R./

Examiner, Art Unit 3689

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629